

anhydrides was not refuted. However, to specifically select mixed anhydrides in the expectation to obtain an advantage is not at all taught. Applicants already pointed to the fact that the skilled person would have to select mixed anhydrides from the following list (from column 4, lines 55-68 of Reichert et al.):

preferred aliphatic anhydrides such as:

acetic anhydride

succinic anhydride

phthalic anhydride

other aliphatic anhydrides such as:

propionic anhydride

butyric anhydride

valeric anhydride

unsaturated aliphatic anhydrides such as:

crotonic anhydride

maleic anhydride

aromatic anhydrides such as:

benzoic anhydride

naphthalenic anhydride

mixtures of anhydrides

mixed anhydrides.

From, this large list the skilled person would have to select the mixed anhydrides, although these are clearly not preferred by Reichert et al.. Such act of selection would be non-obvious per se. It would be a classic "safedial" situation, analogous to selecting a specific combination of numbers capable of opening a safe when selected from a large number of possibilities proffered by the safedial (Ex Party Garvey, 41 USPQ 583).

If, for the sake of argument only, the skilled person would have selected the mixed anhydrides from the above list, the instant invention would still not be obtained, because the present invention only claims mixed anhydrides having the

formula $R^1[C(O)OC(O)OR^2]_n$ or $[R^3C(O)OC(O)O]_pR^4$, wherein R^1 - R^4 , and n and p , have the indicated meanings.

Windholz and Tarbell et al. only disclose that mixed anhydrides in general were known at the time of filing. This is admitted by the Examiner. The Examiner, however, cannot be followed in her analyses that the skilled person would have any incentive to choose the known mixed anhydrides of Windholz or Tarbell and apply them to a process to which neither reference provides the slightest hint. Where is the motivation (teaching, suggestion or incentive to a person of ordinary skill) that the law requires to make such a combination (United States Surgical Corp v, Ethicon Inc., 41USPQ2d 1225)? Such a mosaic combination of documents as attempted by the Examiner could not be accomplished without knowledge of the present invention, and that is an impermissible exercise in hindsight (W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303).

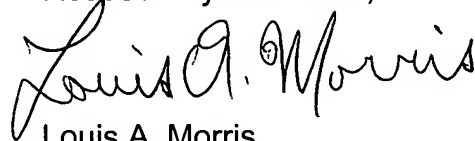
It is further of significant importance to note that in fact neither Windholz nor Tarbell even disclose the instantly claimed mixed anhydrides. Windholz discloses mixed anhydrides having the formula $R^1C(O)OC(O)OR^2$, wherein $n = 1$ only (we have claimed $n = 1-4$), whereas R^1 and R^2 are defined as $R^1 = C_2H_5$; $C_6H_5-C_2H_4$; or $N\equiv C-C_2H_4$, and $R^2 = C_2H_5$. Compounds having the formula $[R^3C(O)OC(O)O]_pR^4$ are not disclosed at all. This clearly does not correspond with the definitions of claim 1.

Tarbell discloses mixed anhydrides having the formula $R^1C(O)OC(O)OR^2$, wherein $n = 1$ only (in the instant claims $n = 1-4$), whereas R^1 and R^2 are defined as $R^1 = CH_3$; C_2H_5 ; C_6H_5 , or ortho-AcO- C_6H_4 ; and $R^2 = C_2H_5$, or wherein $R^1 = R^2 = C_6H_5$. Tarbell does not disclose compounds having the formula $[R^3C(O)OC(O)O]_pR^4$. Tarbell, therefore, discloses compounds outside of the instant claims, and has only a very small overlap with the claimed compounds.

Thus, even if Reichert is combined with either one of Windholz and Tarbell, notwithstanding the lack of incentive for the skilled person to do so, the instantly claimed mixed anhydrides are still not obtained. The Examiner has, therefore, not even stated a *prima facie* case, since the references, when combined, do not teach or suggest all the claim limitations (MPEP 2143).

Applicants respectfully request that the instant application be afforded fair reconsideration, in which case patentability of the instant claims could be the only rational conclusion.

Respectfully submitted,

A handwritten signature in black ink, reading "Louis A. Morris". The signature is fluid and cursive, with the first name "Louis" and last name "Morris" clearly legible.

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